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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,813	03/30/2004	Shiu-Lan Liu	P-3641.278	5067
7590 03/30/2006				
Jackson Walker L.L.P. Suite 2100 112 E. Pecan Street San Antonio, TX 78205		EXAMINER MOHANDESI, JILA M		
		ART UNIT 3728		PAPER NUMBER

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/812,813	Applicant(s) LIU ET AL.	
	Examiner Jila M. Mohandesi	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGivern (3,333,593) in view of Aylott (3,504,682). McGivern '593 discloses an eyelid enhancement kit comprising: a package having a first compartment; a first tray (insert 21) received in the first compartment and having a first recess and a second recess (grooves 14) respectively defined in a top face of the first tray and a cover (12) covering the first tray; a first eyelid mask and a second eyelid mask (false eyelashes 15) sandwiched between the first tray and the cover and respectively received in the first recess and the second recess of the first tray; wherein the cover has a first protruding (protuberance 24) area formed on a bottom face of the cover to correspond to the first recess and a second protruding area (protuberance 24) formed on the bottom face of

the cover to correspond to the second recess so that the first protruding area and the second protruding area are able to be respectively received in the first recess and the second recess to securely sandwich the first eyelid mask and the second eyelid mask. See Figures 1-4 embodiments. McGivern '593 does not appear to disclose a second compartment with a second tray and recess for holding a brush and cutouts for the recesses. Official notice is taken that it is old and conventional to provide additional compartments with trays to kits to provide for additional storage space. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the official notice to provide an additional compartment with additional tray with recess for holding additional items in the kit of McGivern '593, since it has been held that mere duplication and rearranging of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8 and *In re Japikse*, 86 USPQ 70.

Aylott '682 discloses that it is desirable to provide a brush with eyelid masks for cleaning and use with the eyelid masks. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an brush to the modified kit of McGivern '593 as taught by Aylott '682 to be used with the eyelid masks.

With respect to claim 2, official notice is taken that it is old and conventional to provide cutouts for recesses in a tray for easier removal of items held therein. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the official notice to provide cutouts for the recesses in the tray of McGivern '593 for easier removal of the items being held therein.

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4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claim 1-3 above, and further in view of Hirzel (5,176,754).

McGivern '593 as modified above discloses all the limitations of the claims except for the brush having a rubber cap formed on a distal end of the eyelid brush. Hirzel '754 discloses that it is desirable to have apparatus for applying cosmetics with double applicator means such as a brush and a rubber cap to have multiple functions.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the brush of McGivern '593 with double applicator such as brush and a rubber cap as taught by Hirzel '754 for multiple applications.

Conclusion

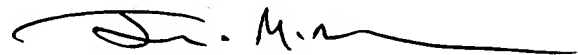
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are eyelid enhancement kits analogous to applicant's instant invention.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
March 28, 2006

J